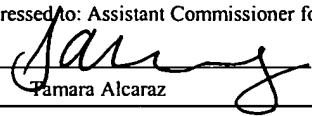


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PATENT
Docket No. 293102003000

#13
Election
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 Tamara Alcaraz	

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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OCT 11 2002

In the application of:

Suresh K. TIKOO et al.

Serial No.: 09/871,212

Filing Date: May 31, 2001

For: MODIFIED BOVINE ADENOVIRUS
HAVING ALTERED TROPISM

Examiner: U. Winkler

Group Art Unit: 1648

TECH CENTER 1600/2900

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This is in response to the non-final Office Action dated September 6, 2002 (Paper No. 11) which set forth a restriction requirement for pending claims 1-63. A response is due on October 7, 2002 (since October 6, 2002 fell on Sunday). Accordingly, this response is timely filed.

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Restriction Requirement

The Examiner requires restriction to one of the following inventions:

Group I, claims 1-17, 21, 22, 25, 27, 28, 35, and 39-51 which the Examiner characterizes as drawn to a bovine adenovirus with a modification in the capsid protein and a host cell comprising the modified virus. Applicants note that claims 43-51 are drawn to immunogenic compositions comprising a bovine adenovirus.

Group II, claims 1, 18, 19, 22, 23, 26, 36, and 37, which the Examiner characterizes as drawn to a bovine adenovirus with a modification in the capsid protein where E1 lacks function. Applicants point out that claim 22 is dependent upon claim 21 and neither claim 21 nor claim 22 recite wherein E1 lacks function. Applicants point out that claim 36 is dependent upon claim 35 and neither claim 35 nor claim 36 recite wherein E1 lacks function. Applicants respectfully request clarification of the claims in Group II.

Group III, claims 1, 20, 22, 24, 36, and 38, which the Examiner characterizes as drawn to bovine adenovirus with the modification in the capsid protein where E3 is deleted. Applicants point out that claim 22 is dependent upon claim 21 and neither claim 21 nor claim 22 recite wherein E3 is deleted. Claim 36 is dependent upon claim 35 and neither claim 35 nor claim 36 recite wherein E3 lacks function. Applicants respectfully request clarification of the claims in Group III.

Group IV, claims 1, 21, 22, 28, 36, and 52-54 which the Examiner characterizes as drawn to a bovine adenovirus with a modification in the capsid protein and comprising a polynucleotide encoding a heterologous protein. Applicants point out that claims 52-54 are composition claims.

Group V, claims 29-34 which the Examiner characterizes as drawn to a method of making a bovine adenovirus vector

Group VI, claims 55 and 56 which the Examiner characterizes as drawn to a method of eliciting an immune response.

Group VII, claims 57-63 which the Examiner characterizes as drawn to a method of delivering a gene to a mammalian host cell.

For groups I, V and VII, the Examiner further requires election from among species 1. Hexon protein, 2. Penton protein and 3. Fiber protein. For groups I, IV and VI, the Examiner requires election from among inventions (A)-(T) listed in the Office Action. Applicants request clarification as to the requirement of election from among inventions (A)-(T) if groups II and III are elected.

The Examiner states that claim 1 links inventions I-IV. The Examiner states that claim 22 links inventions II-IV. Applicants point out that claim 22 was also placed in Group I by the Examiner. Therefore, claim 22 links inventions I-IV. Applicants note that claim 28 links inventions I and IV. Applicants note that Claim 36 links inventions II-IV. As stated by the Examiner, the restriction among the linked inventions is subject to the nonallowance of the linking claims, i.e., claims 1, 22, 28 and 36.

Applicants traverse this restriction requirement. The Examiner states at page 6, second paragraph that Groups I and VI are compositions and each is distinct from the other because they contain different structures. Applicants believe the Examiner intends to recite Groups I and "IV". The Examiner states that there may be overlap for these groups. In fact, Group I is related to Groups II, III, and IV as sub-combination / combination and the USPTO is obligated to follow its own rules. See MPEP 806.05. There is no search burden placed upon the Examiner in examining these groups together, because the search for the sub-combination, that is, an adenovirus in which the capsid protein has been modified, is contained within the search for the combinations, that is Groups II, III and IV.

For example, Applicants note that claim 27 which recites a bovine adenovirus vector comprising a modification in a polynucleotide encoding a capsid protein and claim 28, which recites a bovine adenovirus vector comprising a modification in a polynucleotide encoding a capsid protein and polynucleotide encoding a heterologous protein are placed in the same group, Group I. The Examiner has determined that there is no search burden in searching these two

claims together. Therefore, Applicants request rejoinder of Groups I and IV. There is no search burden placed upon the Examiner in examining Groups I and II together, because the search for Group I is fully contained within the search for Group II claims. Therefore, Applicants request rejoinder of Groups I and II. There is no search burden placed upon the Examiner in examining Groups I and III together, because the search for Group I is fully contained within the search for Group III. Therefore, Applicants request rejoinder of Groups I and III.

Additionally, Applicants request rejoinder of methods claims to the extent that they recite the limitations of allowed compositions claims. In re Ochiai.

Applicants hereby elect Group I (claims 1-17, 21, 22, 25, 27, 28, 35, and 39-51), invention (3) and (K), with traverse. Applicants expressly reserve his/her rights under 35 U.S.C. § 121 to file a divisional application directed to the nonelected subject matter during the pendency of this application, or an application claiming priority from this application.

Applicants request examination of the elected subject matter on the merits.

Drawings

The Office Action includes a form PTO-948. While Applicants believe that the form PTO-948 refers to correction of informalities, Applicants include substitute Figs. 8 and 17A-17G.

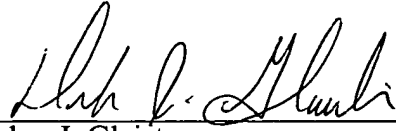
In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 293102003000. However,

the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

Dated: October 7, 2002

By:



Debra J. Glaister
Registration No. 33,888

Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, California 94304-1018
Telephone: (650) 813-5725
Facsimile: (650) 494-0792